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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,643	03/16/2001	Robert C. Pittenger	N0391/7005 SJH	7392
7590	03/24/2006		EXAMINER KAZIMI, HANI M	
Steven J. Henry Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue Boston, MA 02210			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,643

Applicant(s)

PITTENGER, ROBERT C.

Examiner

Hani Kazimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/09/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-6 are pending. The objections and rejections cited are as stated below:

Claim Objections

2. Claim 2 is objected to because of the following informalities:

Claim 2, limitation (d) contains a spelling error, "tot he" should be --to the--.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

4. Claims 1-6 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-6 are rejected under 35 U.S.C. § 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. The mere fact that the claim performs evaluation steps and then assigns a grade based on the evaluation steps does not satisfy the requirement of 35 U.S.C. 101. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea that performs mental steps and therefore non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Making the Grade, “Morningstar announces proprietary stock grading system”, (hereinafter “Morningstar”).

Claims 1, 3, 4 and 6, Morningstar discloses a method and corresponding system for grading a stock of a publicly traded company, comprising the steps of evaluating the financial, business performance of the company against a pre-determined set of business performance criteria, evaluating the market performance of the stock against predetermined stock performance criteria, assigning to the stock a grade based upon

the evaluated performances, using predetermined criteria (page 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

9. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Making the Grade, "Morningstar announces proprietary stock grading system", (hereinafter "Morningstar").

Claims 3 and 5, Morningstar teaches a method and corresponding system for grading a stock of a publicly traded company, comprising the steps of evaluating the financial, business performance of the company against a pre-determined set of business performance criteria, evaluating the market performance of the stock against

predetermined stock performance criteria, assigning to the stock a grade based upon the evaluated performances, using predetermined criteria (page 1).

Morningstar fails to teach the step of assigning to the stock a second grade based upon a history over time of assigned first grades.

Official Notice is taken that moving average calculations for historical data is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Morningstar to include the step of assigning to the stock a second grade based upon a history over time of assigned first grades, because it greatly improves the efficiency of the system by providing the user with an easy and simple way of spotting trends and predicting stock performance.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

March 20, 2006